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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,155	12/16/2005	Sciji Mizohata	Q91918	9130
23373 7590 05/13/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER GRAY, JILL M	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 05/13/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/561,155

**Applicant(s)**

MIZOHATA ET AL.

**Examiner**

Jill Gray

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

The rejection of claims 2, 4, 7, 11-13, and 18-20 under 35 U.S.C. 112, second paragraph is moot in view of applicants' amendments.

The rejection of claims 2-5, and 14 under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 is withdrawn in view of applicants' arguments.

The rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 in view of Azuse et al., US 2003/0024052 is withdrawn in view of applicants' arguments.

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 6-8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 (the publication) for reasons of record.

The publication discloses a polyether ester elastic fiber of the type contemplated by applicants containing a polyether ester elastomer containing polybutylene terephthalate hard segments and polyoxyethylene glycol soft segments, per claim 1. See entire document, and for example, page 3, line 55 and page 4, line 2. The publication also discloses that the hard segments and soft segments are present in amounts within the instant claimed range as required by claims 8 and 15. See page 8, lines 28-31. Regarding properties such as the coefficient of moisture absorption and

water absorption (claim 1) as well as claims 6-7, the polyether ester elastic fiber of the prior art is substantially the same as that contemplated by applicants, accordingly it is the examiner's position that these properties of the prior art fiber are the same as or substantially similar as well in the absence of factual evidence to the contrary. Applicants are invited to provide such evidence.

Therefore, the teachings of the publication would have rendered obvious the invention as claimed in present claims 1, 6-8 and 15.

3. Claims 9-10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 (the publication) in view of Azuse et al, US 2003/0024052 A1 (Azuse), for reasons of record.

The publication is as set forth above but does not teach the application of a finishing oil. Azuse discloses lubricants for elastic fibers of the type contemplated by applicants, (see entire document, and for example, abstract, and [0010]) wherein the application to elastic fibers enhance their antistatic properties and prevent said fibers from tacking with one another during processing. It would have been obvious to modify the teachings of the publication by applying a finishing oil as required by applicants and as taught by Azuse, in order to enhance the antistatic properties and prevent tacking during processing. As to the amount of add-on, this amount would have been obvious to determine for optimization purposes during routine experimentation. As to claim 10, Azuse teaches a finishing oil of the type contemplated by applicants, thus, it is the examiner's position that properties such as the viscosity would be similar as that set forth by applicants, in the absence of factual evidence to the contrary.

Therefore, the combined teachings of the publication and Azuse would have rendered obvious the invention as claimed in present claims 9-10 and 17.

4. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 (the publication) in view of Japanese Patent Publication JP 62-243873 abstract (the abstract).

The publication is as set forth above but does not teach the polyether ester elastomer copolymerized with a metal organic sulfonate. The abstract teaches deodorizing polyester fibers comprising a polyester copolymerized with a metal sulphonate, wherein the preferred polyesters include polybutylene terephthalate. It would have been obvious to the skilled artisan to modify the teachings of the publication by copolymerizing the metal sulfonate to produce an elastic fiber having a good deodorizing effect.

Therefore, the combined teachings of the publication and the abstract would have rendered obvious the invention as claimed in present claims 2-5.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 821 086 (the publication) in view of Azuse et al, US 2003/0024052 A1 (Azuse), and further in view of Japanese Patent Publication abstract JP 62-243873 (the abstract).

The publication and Azuse are as set forth above, but do not teach the copolymerization of the polyether ester elastomer copolymerized with a metal organic sulfonate. The abstract teaches deodorizing polyester fibers comprising a polyester copolymerized with a metal sulphonate, wherein the preferred polyesters include

polybutylene terephthalate. It would have been obvious to the skilled artisan to modify the teachings of the publication by copolymerizing the metal sulfonate to produce an elastic fiber having a good deodorizing effect.

Therefore, the combined teachings of the publication and the abstract would have rendered obvious the invention as claimed in present claim 16.

### ***Response to Arguments***

6. Applicant's arguments filed February 9, 2009 have been fully considered but they are not persuasive.

Applicants argue that the EP '086 publication discloses a polyether ester elastic fiber, but the polybutylene terephthalate portion is only explained as an example of the hard segment and polyoxyethylene glycol is only explained as an example of the soft segment, and the examples do not disclose polyether ester elastomer containing polybutylene terephthalate as a hard segment and polyoxyethylene glycol as a soft segment.

In this regard, it is the examiner's position that the teachings in the prior art reference are not limited solely to what is taught in the examples, but must be relied upon for all that the reference would reasonably convey to one having ordinary skill in the art at the time the invention was made. In the instant case, the teachings in the publication clearly set forth polybutylene terephthalate as a suitable polyester for the hard segment. This teaching would have provided motivation to the skilled artisan for said polyester.

Arguments with respect to claims 2-5 and 14 are moot.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Gray/  
Primary Examiner  
Art Unit 1794

jmg